

## **REMARKS**

The Examiner rejects claims 1, 3-6, 9-13, 15, 88, 89, 91-94, 97-101, and 103. The Examiner objects to claims 2, 7, 8, 14, 16-25, 90, 95, 96, 102, and 104-113. The Examiner has withdrawn claims 26-87. Claim 89 has been cancelled without prejudice or disclaimer. Applicant has added no new claims. Claims 1-25, 88, and 90-113 are pending and under consideration.

Claims 1 and 88 have been amended to recite the language "macerating whole tissue, wherein the whole tissue is not blood" to replace the language "releasing nucleic acids from a biological sample." Claim 88 has also been amended to replace the language "biological sample" with the language "whole tissue." Support for these amendments may be found in the specification, e.g., at page 14, lines 8-17; Example 2, page 24, line 5 to page 25; and Examples 7 to 9, page 36, line 4 to page 45, line 8. These amendments add no new matter.

### **Objections to Claims**

The Examiner objects to claims 2, 7, 8, 14, 16-25, 90, 95, 96, 102, and 104-113 as being dependent upon a rejected base claim. See Office Action, pages 3-4, Item 5.

As the Applicant shows below, the base claims upon which the objected claims are dependent are in condition for allowance, and the Examiner's objection is moot. Applicant respectfully requests reconsideration and withdrawal of the claim objections.

### **Rejection Under 35 U.S.C. § 102(e)**

The Examiner rejects claims 1, 3-6, 9-13, 15, 88, 89, 91-94, 97-101, and 103 under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Pat. No. 6,548,256 to Lienau et al., ("Lienau"). Office Action at page 3, Item 4.

The Examiner states that "Lienau discloses a method and kit for isolating nucleic acids from a nucleic acid containing starting material, where the nucleic acids are released from the starting material and precipitated onto a trapping membrane." Office Action at page 3, lines 5 to 7. The Examiner states that "[t]he method and kit may be used in the context of isolating genomic DNA from blood and isolating BACs from transformed bacterial cultures." Office Action, page 3, lines 7 to 9. "One method includes mixing the starting material with a lysing and denaturing substance for release of the nucleic acid from the starting material. Typically, the lysing and denaturing substance includes a buffering agent, a salt, a detergent and a protease ... . The detergent is a quaternary amine cationic detergent ... ." Office Action at page 3, lines 9-18.

Without acquiescing to the Examiner's rejection and solely to expedite prosecution, claim 89 has been cancelled without prejudice or disclaimer and claims 1 and 88 have been amended to recite the language "macerating whole tissue, wherein the whole tissue is not blood" and to replace the language "biological sample" with the language "whole tissue." Support for these amendments may be found in the specification, e.g., at page 14, lines 8-17; Example 2, page 24, line 5 to page 25; and Examples 7 to 9, page 36, line 4 to page 45, line 8.

Lienau discusses compositions for obtaining nucleic acid from single cells in suspension, but not for "macerating whole tissue, wherein the whole tissue is not blood" as recited in claims 1 and 88. The only starting materials that "have a target nucleic acid for isolation" listed by Lienau are collections of single cells or cells in a liquid suspension, such as blood or saliva. Such collections of single cells or cells in liquid

suspension are not literally encompassed by the language “macerating whole tissue” in claims 1 and 88.

Nowhere does Lienau teach a method of “macerating whole tissue.” Thus, Lienau does not disclose compositions for the macerating whole tissue. Thus, Lienau does not anticipate claims 1 and 88. Claims 3-6, 9-13, 15, 91-94, 97-101, and 103 ultimately depend from one of claims 1 and 88. Thus, Lienau does not anticipate claims 3-6, 9-13, 15, 91-94, 97-101, and 103.

Claim 88 further recites a composition that comprises “whole tissue, where the whole tissue is not blood.” As discussed above, nowhere does Lienau describe whole tissue. Thus Lienau cannot disclose a composition comprising whole tissue, as recited in claim 88.

Claims 91-94, 97-101, and 103 ultimately depend from claim 88. Thus, in addition to the reasons given previously, Lienau does not anticipate claims 91-94, 97-101, and 103.

Applicant respectfully requests reconsideration and withdrawal of the §102 rejection.

#### Conclusion


Applicant respectfully asserts that the application is in condition for allowance. If the Examiner does not consider the application to be in condition for allowance, Applicant requests that the Examiner call the undersigned at (650) 849-6676 to arrange an interview prior to taking action.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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GARRETT & DUNNER, L.L.P.

Dated: February 27, 2004

By:   
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